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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,999	11/21/2003	Seunghun Hong	FSUN-002/01US	9094
23419	7590	02/03/2006	EXAMINER	
COOLEY GODWARD, LLP 3000 EL CAMINO REAL 5 PALO ALTO SQUARE PALO ALTO, CA 94306			LAM, CATHY FONG FONG	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,999

Applicant(s)

HONG, SEUNGHUN

Examiner

Cathy Lam

Art Unit

1775

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) 1-91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 92-97 and 100-108 is/are rejected.
- 7) ☒ Claim(s) 98 and 99 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-5 & 10-15-2004</u> . | 6) <input type="checkbox"/> Other: ____. |

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-91, drawn to a process of depositing nanowires, classified in class 427, subclass 58+.
 - II. Claims 92-108, drawn to a nanowire based device, classified in class 428, subclass 209.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a different process such as by dispersing nanowires into an organic medium which is an uncured material, then apply onto a metallic substrate. The process as claimed can be used to make a different product such as a decalcomania.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Atty: Cliff Liu on Jan 19th 2006 a provisional election was made with traverse to prosecute the invention of group II, claims 92-108. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-91 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. Claim 108 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 108 is structurally indefinite, as it is unclear since a first nanowire has already been deposited onto the first plurality of organic molecules (as in claim 102). Clarification is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 92-97 and 100-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe (US 6522446).

Saxe discloses an electro-optical device comprised of anisometrically shaped metal particles suspended in a liquid medium.

The metal particles have an average length between about 1 micron to 50 nanometer, more preferably between about 75-180 nm (col 4 L 47-51). The metal particles have a variety of physical forms (col 4 L 61-65). The examiner is taking the position that the metal particles are nanowires, since they can come in fibrils, rods or cylinders shapes.

The metal particles are dispersed and suspended in a liquid suspending medium (or an organic medium) (col 4 L 43-44). The metal particles in the liquid medium is associated with electrodes which electrical energy is applied and to the metal suspension (col 4 L 43-47).

The liquid suspending medium is a polymeric material that has sufficient number of polar groups to bond to the metal particles. The high polarity groups include carboxyl group (or -COOH) (col 6 L 35-38).

The prior art teaches a nanowire suspended in a polar organic medium. The suspended metal particles are deposited onto a substrate (col 8 L 5-8).

The prior art however does not go into details of the organic medium as to whether it includes conjugated π bonds. The prior art is also silent about having a gold conductive layer as the substrate.

In view of the prior art teaching, one skill in the art would choose an appropriate conductive layer and the organic medium for bonding nanowires to the conductive layer because finding an optimum material(s) for the invention involves only routine experimentation.

Allowable Subject Matter

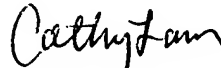
8. Claims 98 and 99 are objected to as being dependent upon a rejected base claim, but would be allowable if incorporate into independent claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy Lam whose telephone number is (571) 272-1538. The examiner can normally be reached on 9am-6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cathy Lam
Primary Examiner
Art Unit 1775

cfl
January 26, 2006